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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,874	09/27/2005	Henrik Przybilla	AT03 0014US1	1786
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NXP, B.V. NXP INTELLECTUAL PROPERTY & LICENSING M/S41-SJ 1109 MCKAY DRIVE SAN JOSE, CA 95131			EXAMINER PATEL, NIRAV B	
			ART UNIT 2435	PAPER NUMBER
			NOTIFICATION DATE 11/25/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/550,874	<b>Applicant(s)</b> PRZYBILLA, HENRIK	
	<b>Examiner</b> NIRAV PATEL	<b>Art Unit</b> 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's amendment filed on July 29, 2009 has been entered. Claims 1-20 are pending. Claims 1, 7, 8, 10, 16 are amended and Claims 18-20 are newly added by the applicant.

### **Claim Objection**

2. Claims 7 and 8 are objected to because of the following informalities:

Claims 7 and 8 recite the limitation "the data carriers", are objected for lacking proper antecedent basis.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 10, 11, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Richards et al. (US Patent No. 6,230,267).

As per claim 10, Richards teaches:

A data carrier for running at least one application, the data carrier comprising: at least one interface for the contactless and/or contact communication of information items [Fig. 1A, 11], computer means for running the at least one application, where

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information items communicated via the interfaces or information items stored in the data carrier are processed [Fig. 11, associated text], and having storage means for storing a first key information item (e.g. IC card key), a first master key information item separate from the first key information item (e.g. CA's key) and an associated data carrier identification information item that identifies the data carrier [Fig. 4, 11, col. 7 lines 63-65, col. 10 lines 39-40, 49-52], checking means for checking a modification right of a modification device to modify an application in the data carrier via the interface, where the checking means are designed to check the association of the first key information item stored in the storage means with the second key information item output to the data carrier by the modification devices, modification means which, following confirmation of the modification right of the modification device by the checking means, are designed to enable modification of the application in the data carrier by the modification device [Fig. 1A, 1B, 9, col. 10 lines 18-67, col. 11 lines 1-60].

As per claim 11, the rejection of claim 10 is incorporated and Richards teaches:

wherein the checking means are designed to confirm a restricted modification right which only gives the right to install and/or update and/or delete the application, in the data carriers [col. 11 lines 42-57].

As per claim 16, Richards teaches:

A modification device for modifying an application in a data carrier, the modification device comprising: at least one interface for the contactless and/or contact

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communication of information items to a data carrier [Fig. 1A, 1B] identified by a data carrier identification information item, storage means for storing at least one data carrier identification information item that identifies a data carrier, and an associated second key information item (e.g. IC card key) and a second master key information item (e.g. CA's key) [Fig. 1A, 1B, col. 6 lines 31-63, Fig. 5, col. 8 lines 30-43], and computer means for modifying applications in data carriers via the interface where, in the course of communication with a data carrier identified by a stored data carrier identification information item, the modification right of the modification device is output to the data carrier by communication of the second key information item associated with this data carrier identification information item, whereupon, following confirmation of the modification right by the data carrier, the modification device is authorized and designed to modify the application in the data carrier [Fig. 9, 10, col. 10 lines 17-67, col. 11 lines 1-59].

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-9, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everett et al. (U. S. Pub. No. 2002/0050528) and in view of Richards et al. (US Patent No. 6,230,267).

As per claim 1, Everett teaches:

A granting method to grant a modification device a modification right to modify an application in a data carrier [Fig. 9], the method comprising: generation of a first key information item and of an associated second key information item for data carrier identified by a data carrier identification information item [paragraph 0040, 0042, 0076, Fig. 3]; generating of a first master key item and an associated second master key information item in addition to the first key information item and the associated second key information item [paragraph 0033 e.g. CA's public key and CA's secret key]; checking the identification personalization data, allowing of the modification of the application in the data carrier by the modification device [paragraph 0055-0059 Fig. 6, 7]. Everett does not expressively mention checking of the association of the first key information item with the second key information item.

However, in the same field of endeavor, Richards teaches: generating of a first master key item and an associated second master key information item in addition to the first key information item and the associated second key information item [CA's public key and CA's private key col. 8 line 40, col. 10 line 40, in addition to the IC card public/secret key pair]; checking of the association of the first key information item stored in the data carrier with the second key information item from the modification

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device; allowing of the modification of the application in the data carrier by the modification device in response to a determination that the first key information item is associated with the second key information item [Fig. 1A, 1B, col. 8 lines 1-67, col. 9 lines 1-9, col. 11 lines 13-31, 42-46].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Richards with Everett, since one would have been motivated to provide secure transfer technique and to provide secure IC-card system that allows for the secure transfer of data to the intended IC card [Richards, col. 2 lines 30-42].

As per claim 2, the rejection of claim 1 is incorporated and Everett teaches:

wherein the modification right gives the right to install and/or update and/or delete the application in the data carrier [paragraph 0055, 0025].

As per claim 3, the rejection of claim 1 is incorporated and Everett teaches:

wherein the modification right only gives the right to modify a specific application in the data carriers [paragraph 0025, 0055, Fig. 6, 7].

As per claim 4, the rejection of claim 1 is incorporated and Everett teaches:

wherein the modification right only gives the right to install an application requiring a predefined maximum amount of storage space in the data carrier [Fig. 7, paragraph 0061].

As per claim 5, the rejection of claim 1 is incorporated and Everett teaches:

wherein the data carrier identification information item identifies a group of data carriers [paragraph 0040, 0008].

As per claim 6, the rejection of claim 1 is incorporated and Everett teaches:

wherein the modification right also determines the access rights of the application that is to be modified in the data carrier to storage areas and interfaces of the data carriers [paragraph 0056, 0059, Fig. 6].

As per claim 7, the rejection of claim 1 is incorporated and Richards teaches:

wherein the modification of access rights in the data carriers and/or the generation of further key information items in the data carriers and the modification device is possible only with the first master key information item stored in the data carrier and only with the second master key information item stored in the modification devices [col. 10 lines 20-48, Fig. 1A].

As per claim 8, the rejection of claim 7 is incorporated and Richards teaches:

wherein the first master key information item and the associated second master key information item only make it possible to modify access rights of a specific application in the data carrier and/or to generate further key information items in the data carrier and



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the modification device in order to modify a specific application [col. 10 lines 20-48, Fig. 1A].

As per claim 9, the rejection of claim 1 is incorporated and Everett teaches:

wherein modification of the application in the data carrier by the modification device of the data carrier is only permitted when specific properties of the application that is to be modified are determined paragraph 0055-0059].

As per claim 18, the rejection of claim 1 is incorporated and Richards teaches:

checking of the association between the first master key information item stored in the data carrier with the second master key information item from the modification device; and allowing a modification by the modification device of access rights to at least one interface of the data carrier in response to a determination that the first master key information item is associated with the second master key information item [col. 10 lines 20-48, Fig. 1A, Fig. 1B, col. 8 lines 1-67, col. 9 lines 1-9, col. 11 lines 13-31, 42-46].

5. Claims 12-15, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards et al. (US Patent No. 6,230,267) and in view of Everett et al. (U. S. Pub. No. 2002/0050528).

As per claim 12, the rejection of claim 10 is incorporated and Everett teaches:

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wherein the checking means are designed to confirm a restricted modification right which only gives the right to modify a specific application in the data carrier [paragraph 0025, 0055, Fig. 6, 7].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Everett with Richards, since one would have been motivated to protect against the improper or undesired loading of application onto IC cards and to provide secure IC-card system that allows for selective availability of smart card applications which may be loaded onto IC cards [Everett, paragraph 0006, 0007].

As per claim 13, the rejection of claim 10 is incorporated and Everett teaches:

the checking means are designed to confirm a restricted modification right which only gives the right to install an application requiring a predefined maximum amount of storage space in the data carrier [Fig. 7, paragraph 0061].

As per claim 14, the rejection of claim 10 is incorporated and Everett teaches:

wherein the checking means are designed to confirm a modification right which determines the access rights of the application that is to be modified in the data carrier to storage areas of the storage means and interfaces of the data carrier [paragraph 0055-0059].

As per claim 15, the rejection of claim 10 is incorporated and Richards teaches the computer means are designed to run an application [Fig. 11, 111- control logic].

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Richards doesn't expressively mention Java applet. Examiner takes official notice that the Java applet loaded onto the data carrier (smart card) were well known at the time the invention was made. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to utilize the Java applet for the smart card was well known.

As per claim 19, the rejection of claim 10 is incorporated and Richards teaches:

the checking means are further configured to check an association between the first master key information item stored in the data carrier with the second master key information item from the modification device; and the modification means are further configured, upon confirmation of the association of the first master key information item with the second master key information item, to enable modification of access rights to the at least one interface for the contactless and/or contact communication [col. 10 lines 20-48, Fig. 1A, Fig. 1B, col. 8 lines 1-67, col. 9 lines 1-9, col. 11 lines 13-31, 42-46].

As per claim 20, the rejection of claim 16 is incorporated and Richards teaches:

wherein the computer means is further configured to modify access rights to at least one interface of the data carrier in response to a determination that the second master key information item is associated with a first master key information item stored on the data carrier [col. 10 lines 20-48, Fig. 1A, Fig. 1B, col. 8 lines 1-67, col. 9 lines 1-9, col. 11 lines 13-31, 42-46].

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richards et al. (US Patent No. 6,230,267) and in view of Ishiguro et al (US Patent No. 5,502,765).

As per claim 17, the rejection of claim 16 is incorporated and Ishiguro teaches the modification device is formed by an operator computer containing the storage means and by a reading device that is connected to the operator computer over a data network, the reading device comprising the at least one interface and at least part of the computer means of the modification devices [Fig. 2].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Ishiguro with Richards, since one would have been motivated to protect against the improper or undesired loading of application onto IC cards and to provide secure IC-card system that allows for selective availability of smart card applications which may be loaded onto IC cards [Everett, paragraph 0006, 0007].

### **Response to Amendment**

7. Applicant has amended claims 1, 7, 8, 10, 16 and added new claims 18-20, which are rejected based on previously cited prior art. See detail rejection above.

Regarding to applicant's argument that the combination of cited reference does not teach first and second master key information items in addition to the first and second key information items, Examiner disagrees since Richards discloses that the CA generates an individualized **key set** for each IC card which is stored on the card, e.g.

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the card's secret key and the card's public key. Further, the CA's secret key is utilized to sign the card's public key and CA's public key is utilized to verify the CA's signature. Therefore, Richards teaches the a first master key information item and an associated second master key information item (i.e. CA's public key/secret key pair) in addition to the first key information item and the associated second key information item (i.e. card's key set). In this case, it meets the claim subject matter.

### Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cromer et al. (US 2002/0129261) – Apparatus and method for encrypting and decrypting data recorded on portable cryptographic tokens

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirav Patel whose telephone number is 571-272-5936. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

*/N. P./*

*Examiner, Art Unit 2435*

*/Kimyen Vu/*

*Supervisory Patent Examiner, Art Unit 2435*